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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,403	02/05/2004	Shinsuke Okada	P24588	3854
7055	7590	12/07/2006	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			KASZTEJNA, MATTHEW JOHN	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 12/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/771,403

Applicant(s)

OKADA, SHINSUKE

Examiner

Matthew J. Kasztejna

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice of Amendment

In response to the amendment filed on September 26, 2006, amended claims 1-4, 6-7 and 10 and new claim 11 are acknowledged. The current rejections under Plummer et al. are *withdrawn*. The rejection of claims 6-7 under 35 U.S.C. 112, second paragraph, is *withdrawn*. The current rejections under Dosaka *stand*. The following new and reiterated grounds of rejection are set forth:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,128,808 to Dosaka.

In regards to claims 1 and 10, Dosaka discloses an objective optical system comprising: a first lens unit 9a having a first lens barrel 9 and a first optical system 6 including a plurality of lens elements assembled in the first lens barrel; and a second lens unit 7a having a second lens barrel 7, engaged to the first lens barrel, and a second optical system 4 including a plurality of lens elements (See Figs. 2 and 4).

In regards to claim 2, Dosaka discloses an objective optical system, wherein the first lens unit is provided with a fixing unit 20 that fixes the first optical system to the first lens barrel, the second lens barrel being assembled to the first lens barrel, the fixing

unit being interposed between the first lens barrel and the second lens barrel to define a clearance therebetween (see Fig. 4).

In regards to claim 3, Plummer et al. discloses an objective optical system, wherein at least one of the first lens unit and second lens unit includes an alignment lens which is movable in a direction perpendicular to the optical axis thereof (see Col. 5, Lines 35-65).

In regards to claims 4-5, Dosaka discloses an objective optical system, wherein the alignment lens is included in the first optical system, the first lens barrel being formed with a plurality of holes through which parts of a circumferential surface of the alignment lens is seen and wherein the alignment lens is movably accommodated in the first lens barrel, the alignment lens being moved by pins inserted through the plurality of holes, respectively (see Figs. 7-8 and Col. 6, Lines 45-68).

In regards to claims 6-8, Dosaka discloses an objective optical system, wherein the alignment lens is configured to be most sensitive with respect to an alignment error among the plurality of lenses included in the first optical system (see Col. 6, Lines 45-68).

In regards to claims 9 and 11, Dosaka discloses an objective optical system, wherein the first lens barrel is attached to the second lens barrel by a screw connection (see Fig. 4 and Col. 5, Lines 35-65).

Response to Arguments

Applicant's arguments filed September 26, 2006 have been fully considered but they are not persuasive.

In response to applicant's arguments, the recitation "an optical system configured to be implemented in a tip of an endoscope" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Applicant states that Dosaka fails to disclose an objective optical system which includes a first lens unit having a first lens barrel, and a second lens unit having a second lens barrel engaged to the first barrel. However, Dosaka clearly discloses an objective optical system comprising: a first lens unit 9a having a first lens barrel 9 and a second lens unit 7a having a second lens barrel 7 engaged to the first lens barrel. As broadly as claimed, shaft 8 engages, meaning to interlock, attach or secure (<http://dictionary.reference.com/browse/engaged>), turrets 7 and 9 to one another.

Applicant states that Dosaka's turrets 7 and 9 do not include a plurality of holes on a circumferential surface thereof which allow access to a predetermined optical element in the turrets. However, Dosaka clearly discloses an optical system wherein the turrets include a plurality of holes 7c through parts of a circumferential surface thereof and also allows access to a predetermined optical element in the turret (see Figs. 7-8 and Col. 6, Lines 45-68).

Applicant states that Dosaka fails to disclose or suggest a fixing unit that fixes a first optical system to a first lens barrel which is interposed between the first lens barrel and a second lens barrel to define a clearance therebetween. However, Dosaka clearly discloses an objective optical system, wherein the first lens unit is provided with a fixing unit 20 that fixes the first optical system to the first lens barrel, the second lens barrel being assembled to the first lens barrel, the fixing unit being interposed between the first lens barrel and the second lens barrel to define a clearance therebetween (see Fig. 4).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

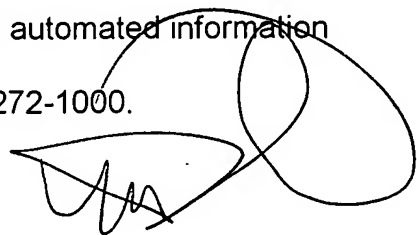
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJK *mjk*

11/29/06



LINDA C. M. DVORAK
SUPERVISORY PATENT EXAMINER
GROUP 3700